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EXAMINER

TRAN, HIEN THI

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/685,382

Applicant(s)

CARLSEN, KURT A.

Examiner

Hien Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 2-26 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 and 19-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2-10, 15-18 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 2-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on 27 May 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Applicant's election of group I, claims 1-10, 15-18, in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 11-14, 19-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 5/27/03 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of heating element 35 surrounding the enclosure 24.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 2-10, 15-18, 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 26, "adapted for" is vague and indefinite as it has been held that the recitation that an element is "adapted for " perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. See claim 15 likewise.

In claim 5, line 2 it is unclear as to which chamber is implied (note the two chambers in claim 26). See claim 7 likewise.

In claim 8, it is unclear as to where the heating element is shown in the drawings.

In claim 10, line 2 "the at least one chemical component" lacks positive antecedent basis as it is merely recited in an intended use clause (note claim 26). Also the chemical component is not a part of the scrubber and therefore the claim is not further limiting.

In claim 17, line 1 "the non-toxic part" lacks positive antecedent basis as it is merely recited in an intended use clause. Also the non-toxic part is not a part of the scrubber and therefore the claim is not further limiting.

In claim 18, line 1 "the toxic part" lacks positive antecedent basis as it is merely recited in an intended use clause. Also the toxic part is not a part of the scrubber and therefore the claim is not further limiting.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 26, 3, 5, 7, 10, 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibana et al (5,271,908).

With respect to claims 26, 3, Shibana et al discloses an apparatus comprising: an enclosure defining a second chamber for receiving exhaust gas having a gas inlet 12, a gas outlet 13, the inlet and outlet being in fluid communication with said chamber; at least one substrate/baffle 14 contained within the enclosure between the gas inlet and the gas outlet; said substrate having a film deposition surface. The first chamber for producing exhaust gas is inherent therein (col. 3, lines 6-17).

With respect to claims 5, 7, Shibana et al discloses a plurality of substrates 14 forming a series of baffles within the chamber, said series of baffles being positioned to define a serpentine passageway (Fig. 1).

With respect to claims 10, 17-18, the claim is directed to method limitation which is not patentable in apparatus claim and therefore the apparatus of Shibana et al structurally meets the claims. In any event, Shibana et al discloses that the exhaust gas includes a chemical component, such as silicon, arsenic (col. 1, lines 25-50).

With respect to claims 15-16, Shibana et al discloses a first enclosure defining a first chamber for receiving the gas (the bottom portion in Fig. 1); a substrate/baffle 14 located in the first enclosure; a second enclosure defining a second chamber (the middle portion and the last portion in Fig. 1) in fluid communication with said first chamber for receiving at least a portion of the gas.

As best understood, instant claims 26, 3, 5, 7, 10, 15-18 structurally read on the apparatus of Shibana et al.

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8. Claims 26, 3-5, 7-8, 10, 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Blickle et al (3,607,104).

With respect to claims 26, 3, Blickle et al discloses an apparatus comprising: an enclosure defining a second chamber for receiving exhaust gas having a gas inlet 11, a gas outlet 13, the inlet and outlet being in fluid communication with said chamber; at least one substrate/baffle 2, 12 contained within the enclosure between the gas inlet and the gas outlet; said substrate having a film deposition surface. The first chamber connected to the second chamber is inherent therein.

With respect to claim 4, Blickle et al discloses that the baffle 2 includes a plurality of apertures (Fig. 1).

With respect to claims 5, 7, Blickle et al discloses a plurality of substrates 12 forming a series of baffles within the chamber, said series of baffles being positioned to define a serpentine passageway (Fig. 1).

With respect to claim 8, Blickle et al discloses provision of a heating means (col. 2, lines 63-64).

With respect to claims 10, 17-18, the claim is directed to method limitation which is not patentable in apparatus claim and therefore the apparatus of Blickle et al structurally meets the claims.

With respect to claims 15-16, Blickle et al discloses a first enclosure defining a first chamber 3 for receiving the gas; a substrate/baffle 12 located in the first enclosure 3; a second enclosure defining a second chamber 4 in fluid communication with said first chamber for receiving at least a portion of the gas.

As best understood, instant claims 26, 3-5, 7-8, 10, 15-18 structurally read on the apparatus of Blickle et al.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibana et al (5,271,908) in view of Smith et al (5,213,767).

Shibana et al fails to disclose whether the substrate may be made of quartz. However, Smith et al discloses provision of using quartz material in making container.

It would have been obvious to one having ordinary skill in the art to alternately select an appropriate material, such as quartz, as taught by Smith et al in the apparatus of Shibana et al, since it has been held to be within the general skill of a worker in the art to select a known

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material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

12. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibana et al (5,271,908) or Blickle et al (3,607,104).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide more than one baffle with apertures, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

It would have been obvious to one having ordinary skill in the art to construct the substrate so as it is removable and reusable in the apparatus of either Shibana et al or Blickle et al for cost saving.

Response to Arguments

13. Applicant's arguments filed 5/27/03 have been fully considered but they are not persuasive.

Applicants argue that the apparatus of Shibana et al or Blickle et al is not adapted for chemical vapor deposition. Such contention is not persuasive as there is no limitation recited in the instant claims to distinguish the difference between the prior art and the instant invention. It should be noted that Shibana et al and Blickle et al disclose all of the structural elements recited in the instant claims.

Applicants argue that the perforated wall 21 in Blickle et al is not a baffle with apertures as recited in the claims. Such contention is not understood as there is no limitation to

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differentiate the perforated wall of Blickle et al and the baffle having apertures of the instant claims.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is 308-4253. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

HT
August 11, 2003


Hien Tran
Primary Examiner
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